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EXAMINER

GRAYSON, ANGELA J

ART UNIT	PAPER NUMBER
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3765

DATE MAILED: 02/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/814,402

Applicant(s)

SINGH ET AL.

Examiner

Angela J. Grayson, Esq.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Amendment filed on 12-30-2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 17-52 is/are rejected.
- 7) ☒ Claim(s) 15, 16, 53 and 54 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3, 6, 8-13 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No 3, 901, 236 to Assarsson et al.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 4, 5, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 3,901,236 to Assarsson in view of US Patent No. 4,354,487 to Oczkowski.

As to claim 1, discloses a web comprising superabsorbent material and fibers wherein at least some of the fibers are coated onto the superabsorbent material prior to formation of the web (See for example Assarsson col. 4 lines 49-50; col. 5 lines 41-44, the web is formed while the superabsorbent material contains a liquid that it has absorbed (Assarsson col. 5 lines 47-49 wherein swelling hydrogen indicates absorbency), and at least some of the liquid absorbed in the superabsorbent is material is removed after formation of the web (Assarsson col. 8 lines 66-68)..

As to claim 2, Assarsson discloses an absorbent article comprising the web of Claim 1. (Assarsson col. 7 lines 62-68).

As to claim 2, Assarsson discloses an absorbent article comprising the web of claim 1. (Assarsson col. 7 lines 62-68).

As to claim 3, Assarsson discloses a web according to Claim 1, wherein removing the liquid comprises causing or allowing evaporation of the liquid. (Assarsson col. 8 lines 66-68 wherein temperature drying implies evaporation).

As to claims 4 and 5, Assarsson discloses a web according to Claim 3, but fails to disclose a web wherein the formed web further has been exposed to conditions that accelerate the evaporation of the liquid and wherein the conditions that accelerate the

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evaporation of the liquid comprise an elevated temperature. Oczkowski makes such a disclosure. (Oczkowski col. 5 lines 41-43). It would have been obvious to one of ordinary skill in the art the time the invention was made to modify procedure of Assarsson with Oczkowski since Oczkowski teaches the process utilizes the theoretical absorbent capacity of the absorbent polymer. (Oczkowski col. 1 lines 5-8).

As to claim 6 Assarsson in view of Oczkowski discloses a web according to Claim 1, wherein the liquid is selected from solutions and mixtures that comprise water. (Assarsson col. 5 lines 47-49).

As to claim 7, Assarsson discloses a web according to Claim 1, wherein the liquid is aqueous, see previous rejection; however, Assarsson fails to disclose the liquid comprises distilled water. However, it would be obvious to one skilled in the art at the time the invention was made to use distilled water since distilled water is commonly used in laboratories and in processing in manufacture.

As to claim 8, Assarsson in view of Oczkowski discloses a web wherein the amount of absorbed liquid present in the superabsorbent material at the time of web formation is at least about 0.5 grams of the liquid per gram of superabsorbent material. Oczkowski makes such a disclosure. (Oczkowski column 5 line 59- col. 6 line 10).

As to claim 9, Assarsson in view of Oczkowski discloses an absorbent article comprising the web of Claim 8. (See Assarsson col. 1 lines 11-16).

As to claim 10 Assarsson in view of Oczkowski discloses a web according to Claim 1, wherein the fibers comprise wood pulp fibers. (See Assarsson col. 4 lines 29-39).

As to claim 11, Assarsson in view of Oczkowski discloses a web according to Claim 1, wherein the fibers have been coated onto the superabsorbent material by combining the fibers and superabsorbent material in the presence of air agitation. (Assarsson co. 8 lines 11-61).

As to claim 12, Assarsson in view of Oczkowski discloses a web according to Claim 1, wherein the web is formed by depositing the coated superabsorbent material onto a surface. (Assarsson co. 7 lines 20-50).

As to claim 13, Assarsson in view of Oczkowski discloses a web according to Claim 1, wherein the web comprises one or more fibers, particles, materials or combinations thereof in addition to the fiber and the superabsorbent material. (Assarsson col. 4 lines 13-46 disclosing mixtures of polymers, fibers and combinations; col. 7 lines 9-19 disclosing additives).

As to claim 14, Assarsson in view of Oczkowski discloses a web according to Claim 1, wherein the superabsorbent material comprises particles. (Assarsson col. 4 lines 24-28).

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 17-52 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,516,569 to Veith.

As to claim 17, Veith discloses a web comprising fibers and superabsorbent material, wherein the web comprises a superabsorbent material content of at least about 60% by dry weight and the web experiences a web loss of less than about 9% when subjected to a Shakeout Test. (See for example Veith Table 1 encompassing cols. 13 and 14).

As to claim 18, Veith discloses an absorbent article comprising the web of Claim 17. (Veith col. 8 lines 27-32).

As to claim 19, Veith disclose the web of Claim 17, wherein the web experiences a web loss of about 5% or less when subjected to a Shakeout Test. (Table 1 encompassing cols. 13 and 14).

As to claim 20, Veith discloses a web comprising fibers and superabsorbent material, wherein the web comprises a superabsorbent material content of at least about 70% by dry weight and the web experiences a web loss of less than about 15% when subjected to a Shakeout Test. (Veith Table 1 encompassing cols. 13 and 14).

As to claim 21, Veith discloses an absorbent article comprising the web of Claim 20. (Veith col. 8 lines 27-32).

As to claim 22, Veith discloses a web of Claim 20, wherein the web experiences a web loss of about 10% or less when subjected to a Shakeout Test. (Veith Table 1 encompassing cols. 13 and 14).

As to claim 23, Veith discloses a web of Claim 20, wherein the web experiences a web loss of about 5% or less when subjected to a Shakeout Test. (Table 1 encompassing cols. 13 and 14).

As to claim 24, Veith discloses a web comprising fibers and superabsorbent material, wherein the web comprises a superabsorbent material content of at least about 80% by dry weight and the web experiences a web loss of less than about 17% when subjected to a Shakeout Test. (Table 1 encompassing cols. 13 and 14).

As to claim 25, Veith discloses an absorbent article comprising the web of Claim 24. (Veith col. 8 lines 27-32).

As to claim 26, Veith discloses web of Claim 24, wherein the web experiences a web loss of about 10% or less when subjected to a Shakeout Test. (Veith Table 1 encompassing cols. 13 and 14).

As to claim 27, Veith discloses a web of Claim 24, wherein the web experiences a web loss of about 5% or less when subjected to a Shakeout Test. (Veith Table 1 encompassing cols. 13 and 14).

As to claim 28, Veith discloses a web comprising fibers and superabsorbent material, wherein the web comprises a superabsorbent material content of at least about 90% by dry weight and the web experiences a web loss of less than about 58% when subjected to a Shakeout Test. (Veith Table 1 encompassing cols. 13 and 14).

As to claim 29, Veith discloses an absorbent article comprising the web of Claim 28. (Veith col. 8 lines 27-32).



As to claim 30, Veith a web of Claim 28, wherein the web experiences a web loss of about 50% or less when subjected to a Shakeout Test. (Veith Table 1 encompassing cols. 13 and 14).

As to claim 31, Veith discloses a web of Claim 28, wherein the web experiences a web loss of about 35% or less when subjected to a Shakeout Test. (Veith Table 1 encompassing cols. 13 and 14).

As to claim 32, Veith discloses a web of Claim 28, wherein the web experiences a web loss of about 20% or less when subjected to a Shakeout Test. (Veith Table 1 encompassing cols. 13 and 14).

As to claim 33, Veith discloses a web of Claim 28, wherein the web experiences a web loss of about 10% or less when subjected to a Shakeout Test. (Veith Table 1 encompassing cols. 13 and 14).

As to claim 34 web of Claim 28, wherein the web experiences a web loss of about 5% or less when subjected to a Shakeout Test. (Veith Table 1 encompassing cols. 13 and 14).

As to claim 35, Veith discloses a web comprising fibers and superabsorbent material wherein the web loss experienced by the web when subjected to a Shakeout Test is not a monotone non-decreasing function of the concentration of superabsorbent material in the web. (Veith Table 1 encompassing cols. 13 and 14).

As to claim 36, Veith discloses an absorbent article comprising the web of Claim 35. (Veith col. 8 lines 27-32).

As to claim 37, Veith discloses a web comprising fibers and superabsorbent material wherein the web loss experienced by the web when subjected to a Shakeout Test is a monotone non-increasing function of the concentration of superabsorbent material in the web. (Veith Table 1 encompassing cols. 13 and 14).

As to claim 38, Veith discloses an absorbent article comprising the web of Claim 37. (Veith col. 8 lines 27-32).

As to claim 39, a web comprising fibers and at least one superabsorbent material at least partially coated with the fibers, wherein individual bodies of the superabsorbent material have bonds with each other, with fibers that are coated upon other bodies of the superabsorbent material, or with a combination thereof, and the superabsorbent material comprises a composition that forms such bonds upon removal of a liquid contained in the superabsorbent material; wherein the bonds can form upon removal from the superabsorbent material of at least about 0.5 grams of the liquid per gram of superabsorbent material. (Veith col. 2 lines 5-34).

As to claim 40, Veith discloses an absorbent article comprising the web of Claim 39. (Veith col. 8 lines 27-32).

As to claims 41, 42, and 43, Veith discloses a web of Claim 39; wherein the removal of the liquid contained in the superabsorbent material comprises evaporation of the liquid; evaporation comprises exposing the web to conditions that accelerate the evaporation of the liquid; wherein the conditions that accelerate the evaporation of the liquid comprise an elevated temperature. (Veith col. 4 lines 31-34).

As to claim 44, Veith discloses a web according to Claim 39, wherein the liquid is selected from solutions and mixtures that comprise water. (Veith col. 4 line 3).

As to claim 45, Veith discloses a web according to Claim 39, but fails to disclose wherein the liquid comprises distilled water. However, it would be obvious to one skilled in the art at the time the invention was made to use distilled water since distilled water is commonly used in laboratories and in processing in manufacture.

As to claim 47, Veith discloses an absorbent article comprising the web of Claim 46. (Veith col. 8 lines 27-32).

As to claim 48, Veith discloses a web according to Claim 39, wherein the fibers comprise wood pulp fibers. (Veith col. 2 lines 54-67).

As to claim 49, Veith discloses a web according to Claim 39, wherein the fibers have been coated onto the superabsorbent material by combining the fibers and superabsorbent material in the presence of air agitation. (Veith col. 1 lines 25-29; col. 12 lines 60-64).

As to claim 50, Veith discloses a web according to Claim 39, wherein the web is formed by depositing the coated superabsorbent material onto a surface. (Veith col. 12 lines 60-64).

As to claim 51, Veith discloses a web according to Claim 39, wherein the web comprises one or more fibers, particles, materials or combinations thereof in addition to the fiber and the superabsorbent material. (Veith col. 2 line 55 - col. 3 line 2).

As to claim 52, Veith discloses a web according to Claim 39, wherein the superabsorbent material comprises particles. (Veith col. 3 line 52).

***Allowable Subject Matter***

8. Claims 14, 15, 53, 54 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

9. Applicant's arguments filed 01-14-2003 have been fully considered but they are not persuasive. As to claims 1-3, 6, and 8-13 Applicant traverses the rejection based on Assarsson by arguing mainly the process by which the hydrogel particles are coated. Applicant argues that the Assarsson rejection should be overcome because the Assarsson hydrogel particles are dried before coated and then they are used whereas Applicant's invention involves hydrogels that are formed and then dried, and further Assarsson teaches away from the claimed invention. However, "Arguments that the alleged anticipatory prior art is nonanalogous art' or teaches away from the invention' or is not recognized as solving the problem solved by the claimed invention, [are] not germane' to a rejection under section 102." *Twin Disc, Inc. v. United States*, 231 USPQ 417, 424 (Cl. Ct. 1986) (quoting *In re Self*, 671 F.2d 1344, 213 USPQ 1, 7 (CCPA 1982)). See *MPEP 2131.05*. Additionally, a comparison of the recited process with the prior art processes does NOT serve to resolve the issue concerning patentability of the product. *In re Fessman*, 489 F2d 742, 180 U.S.P.Q. 324 (CCPA 1974). Whether a product is patentable depends on whether it is known in the art or it is obvious, and is not governed by whether the process by which it is made is patentable. *In re Klug*, 333 F2d 905, 142 U.S.P.Q. 161 (CCPA 1964). In an ex parte case, product-by-process

claims are not construed as being limited to the product formed by the specific process recited. In *re Hirao et al.*, 535 F.2d 67, 190 U.S.P.Q. 15, see footnote 3 (CCPA 1976).

As to claims 17-52, Applicants traverse this rejection based on Veith because the shake-out test values disclosed in Veith are allegedly different than that performed by Applicant in that the regarding Veith, if a tissue was used in making the composite, then the tissue was removed prior to running the test, however, in Applicant's test, if a tissue was used in making the composite, then the tissue is removed prior to running the test. In response to Applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the disparity in the shake-out test) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

As to claims 4-5 and 7, Applicants traverse this rejection based on Assarsson in view of Ockowski because there was no motivation to combine. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, as stated in the rejection

above with respect to said claims, it would have been obvious to one of ordinary skill in the art the time the invention was made to modify procedure of Assarsson with Oczkowski since Oczkowski teaches the process utilizes the theoretical absorbent capacity of the absorbent polymer. (Oczkowski col. 1 lines 5-8).

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patent NO. 4,806,598 to Morman discloses a preparation of webs.


10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Angela J. Grayson, Esq. whose telephone number is 703-305-1806. The examiner can normally be reached on Monday-Thursday from 9:30 am to 7:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John J. Calvert can be reached on 703-305-1025. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0873.

Angela J. Grayson, Esq.   
February 24, 2003

  
JOHN J. CALVERT  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700

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